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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,986	02/09/2001	Michael Brumbaugh	10812/3	2253

7590

06/23/2003

BRINKS HOFER GILSON & LIONE  
P.O Box 10395  
Chicago, IL 60610

EXAMINER

COHEN, AMY R

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,986

Applicant(s)

BRUMBAUGH, MICHAEL

Examiner

Amy R Cohen

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-35 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-35 and 37-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-35, 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over ENC 150 Encoder Mounting Instructions [hereinafter ACU-RITE] in view of Nygren (U. S. Patent No. 5,367,783).

ACU-RITE discloses a method of mounting a position measuring device to a machine tool, comprising: forming holes in a machine tool based on positions of a plurality of mounting holes; aligning said mounting holes of said position measuring device with said holes formed in said machine tool; and attaching said position measuring device to said machine tool (Steps "Saddle Stops" and "Encoder Installation," page 2).

ACU-RITE discloses the method of mounting a position measuring device wherein said position measuring device comprises a linear encoder and wherein attaching said position measuring device comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine tool (Step "Encoder Installation," page 3 and "Cross Feed Installation" figure, page 4).

ACU-RITE discloses the method of mounting wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching said position measuring device (Step "Encoder Installation," pages 2-3).

ACU-RITE discloses the method of mounting comprising attaching said position measuring device to said reading head bracket prior to said positioning and comprising positioning said reading head bracket against said machine tool; and marking mounting holes of said reading head bracket on said machine tool (Steps “Encoder Installation” and “Reading Head Installation,” pages 2-3).

ACU-RITE discloses the method of mounting comprising detaching said position measuring device from said reading head bracket; and attaching said reading head bracket to said machine tool where said mounting holes are located (Steps “Center Support Installation” and “Reading Head Installation,” page 3).

ACU-RITE discloses a method of mounting a position measuring device to a machine tool, comprising: a spar that is to support a position measuring device; forming holes in said machine tool based on positions of a plurality of mounting holes in the spar; aligning said mounting holes of said spar with said holes formed in said machine tool; attaching said spar to said machine tool; and attaching said position measuring device to said spar (Steps “Cross Feed Installation” figure, page 4 and “Spar Assembly,” page 5-6).

ACU-RITE discloses the method of mounting wherein said attaching of said spar comprises inserting screws into said aligned mounting holes of said position measuring device and said holes formed in said machine tool and wherein said machine tool does not move along an axis of travel from the time of positioning to said time of attaching said spar to said machine tool (Step “Spar Assembly,” pages 5-6).

ACU-RITE does not disclose a method of mounting comprising a template comprising a plurality of mounting holes wherein the template is not a linear encoder and wherein the template is supported on a machine tool during positioning.

Nygren discloses a method for mounting a first device to a second device, comprising: positioning a template (1) adjacent to said second device (17), wherein said template comprises a plurality of holes that correspond to mounting holes of said first device (Col 3, line 25-Col 4, line 18) and said template is distinct from said first device (Col 2, lines 23-44); marking holes in said second device based on positions of said plurality of holes (Fig. 2); aligning said mounting holes in said first device with said holes marked in said second device (Col 2, lines 13-22); wherein the template is not the first device (Col 2, lines 23-44) and wherein the template is supported on said second device during said positioning (Fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of mounting of ACU-RITE to include a template comprising a plurality of mounting holes, wherein the template is not the linear encoder and wherein the template is supported by the machine tool, as taught by Nygren, so that a user could save time when installing a linear encoder by using a template which has a plurality of mounting holes and so that a user could install a liner encoder without having to maneuver the linear encoder several times before permanent installation on a machine tool.

***Response to Arguments***

3. Applicant's arguments filed 21 April 2003 have been fully considered but they are not persuasive.

4. In response to applicant's argument that Nygren is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Nygren is pertinent to the particular problem with which the applicant was concerned, marking positions of parts to be fixed to a structural member so as not to damage or overly handle the parts. Nygren discloses the use of a template, which is used for marking the positions of parts to be fixed to a structural member. Nygren uses this template so that the parts to be fixed are not damaged or compromised while marking the structural member (Col 2, lines 13-30).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC  
June 18, 2003



Diego Gutierrez  
Supervisory Examiner  
Tech Center 2800